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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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WORKMAN NYDEGGER/MICROSOFT			VENT, JAMIE J	
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60 EAST SOUTH TEMPLE			PAPER NUMBER	
SALT LAKE CITY, UT 84111			2616	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/650,801

Applicant(s)

POTREBIC ET AL.

Examiner

Jamie Vent

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-18 and 20-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-18 and 20-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on May 4, 2005 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,4,5, 7-18, 20-27, 29-33 are rejected under 35 U.S.C. 102(b) as being unpatentable by Ward et al (US 6,756,997).

[claim 1]

In regard to Claim 1, Ward et al discloses a system that includes a recording apparatus, a method for controlling the recording apparatus in response to programs that have been selected

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for recording and that have been selected for recording and that have coinciding broadcast times, the method comprising the acts of:

- Receiving user input selecting a first program for recording, the first program having a first broadcast time (Figure 2 shows the input means used to input the selection of recording as described in Column 3 Lines 12-67+ through Column 4 Lines 1-20 which describes the receiving of the user input to select information pertaining to recording of the broadcast);
- Receiving user input selecting a second program for recording, the second program having a second broadcast time that at least partially coincides with the first broadcast time and determining that a conflict exists between the first program and the second program and storing, at the system, information specifying that the user has selected both the first and second program to be recorded (Column 10 Lines 47-60 the user can choose two program to be recorded as further discussed in Column 12 Lines 37-67 the conflicts are resolved based on priority of the requested broadcast segment);
- Determining that a conflict exists between the first program and the second program (Column 12 Lines 37-67 describes the system determining that a conflict exists);
- Storing at the system, information specifying that the user has selected both the first and the second program to be recorded (Column 12 Lines 66-67 through Column 13 Lines 1-9 describe the storing of information of a desired recording so that the recording can occur at later time that does not result in a conflict with the first priority program);

- the system automatically selecting the first program for recording in accordance with priority rules (Column 12 Lines 45-65 describes the system selecting the first program that has priority);
- programming the recording apparatus to schedule recording of the first program at the first broadcast time (Column 12 Lines 45-65 further describes the recording of the first broadcast at the first broadcast time due to the resolving of the conflict); and
- subsequent to programming the recording apparatus, continuing to store, at the system, the information specifying that the user has selected both the first program and the second program to be recorded, wherein the continued storage preserves the possibility of resolving the conflict at a later time (Column 12 Lines 65-67 through Column 13 Lines 1-15 describes the storing of the second program information for finding an additional program at a time whenever conflict does not occur).

[claim 2]

In regard to Claim 2, Ward et al discloses a method further comprising the act of communicating to the user information specifying that the conflict exists and that the second program is to be recorded only if the conflict is resolved prior to the second broadcast time (Column 13 Lines 48-54 describe the communication that occurs from the system stating that a conflict exists).

[claim 4 & 5]

In regard to Claims 4 and 5 Ward et al discloses the following acts:

- in response to a subsequent event, the system automatically reevaluating the conflict based on the stored information, the subsequent event occurring subsequent to program the recording apparatus to schedule recording of the first

program (Column 12 Lines 60-67 through Column 13 Lines 1-9 discloses a system automatically detects a conflict occurring); and

- Programming the recording apparatus to schedule record the second program at the second broadcast time (Column 12 Lines 60-67 through Column 13 Lines 1-9 describes scheduling the second program at a different time to avoid the conflict);
- reevaluating that the conflict has been resolved is conducted in response to the first program having been preempted such that the first program is not broadcast at the first broadcast time (Column 13 Lines 1-10 describes the reevaluation of the programs to determine if conflict has been resolved).

[claims 7 & 8]

In regard to Claims 7 and 8, Ward et al discloses a method wherein the act:

- reevaluating the conflict is conducted in response to at least one of a start time and an end time of at least one of the first program and the second program changing from that which was scheduled, such that no portion of the first program coincides with any portion of the second program (Column 11 Lines 50-63 describes the reevaluating of broadcast times);
- reevaluating the conflict comprises of the act of analyzing broadcast data broadcast on a channel that includes one of the first program and the second program, the broadcast data identifying said at least one of the start time and the end time of said at least one of the first program and the second program (Column 12 Lines 35-67 describe the evaluation of the two set recorded programs).

[claims 9 &10]

In regard to Claims 9 and 10, Ward et al discloses a methods comprising:

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- determining that an episode of the second program to be shown at the second program to be shown at the second broadcast time is also to be shown at another broadcast time that does not conflict with the first broadcast time, thereby resolving the conflict (Column 12 Lines 66-67 through Column 13 Lines 1-20 describe the determination that the second program is available at a second broadcast time); and
- User input selecting the first program for recording specifies that the recording of the first program is optional and is to be overridden by a subsequent selection of a conflicting program (Column 12 Lines 36-67 describes the user selecting the importance of the program and thereby letting the user determine importance of the program).

[claim 11]

In regard to Claim 11, Ward et al discloses the method for resolving a conflict between programs, as stated in Claim 1, with the additional limitations:

- Automatically determining that the second program also has another showing at another broadcast time that does not coincide with the first broadcast time (Column 12 Lines 52-67 through Column 13 Lines 1-10 states that it is determined that the second program is shown at an additional time); and
- Automatically scheduling apparatus to record the first program at the first broadcast time and said other showing of the episode of the second program at the said other broadcast time (Column 12 Lines 35-55 describes the automatically scheduling of the recording of the programs)..

[claims 12 &13]

In regard to Claims 12 and 13, Ward et al discloses the act of the system of:

- analyzing data associated with an electronic program guide comprises the act of finding a program listing associated with said other showing by determining that a program identifier included in said program listing associated with said other showing matches a program identifier included in a program listing associated with said showing of said episode of said second program (Column 13 Lines 1-10 describes the listing of the data in the program guide that determines if additional times are being shown of that broadcast).

[claims 14 & 15]

In regard to Claims 14 and 15, Ward et al discloses the following methods of:

- communicating to the user information indicating that said other showing of the episode of the second program is to be recorded at said other broadcast time (Column 13 Lines 1-10 describes that the user informed that the second program is being recorded at an additional time);
- The other showing of the second program is to be broadcast on a channel from the channel on which said selected showing of the episode is to be broadcast (Figure 13 Lines 1-18 describe the search of the other program to be through additional channels and time slots).

[claim 16]

In regard to Claim 16, Ward et al discloses a system that includes a recording apparatus comprising:

- The act of receiving user input selecting a first program for recording comprises an act of receiving input selecting a repeating first program to be recorded on a repetitive basis (Figure 2 shows the input means used to input the selection of recording as described in Column 3 Lines 12-67+ through Column 4 Lines 1-20

which describes the receiving of the user input to select information pertaining to recording of the broadcast);

- The act of receiving user input selecting a second program for recording comprises an act of receiving input selecting a second program for recording, the second program having a broadcast time that at least partially coincides with at least one showing of the repeating first program but does not coincide with other showings of the repeating first program (Column 10 Lines 48-67 describes the systems function of selecting program to be recording based on if a recording conflict occurs).

[claim 17]

In regard to Claim 17, Ward et al discloses a method wherein:

- The act of receiving input selecting the repeating first program is conducted prior to the act of receiving input selecting the second program (Figure 2 shows the input means used to input the selection of recording as described in Column 3 Lines 12-67+ through Column 4 Lines 1-20 which describes the receiving of the user input to select information pertaining to recording of the broadcast); and
- Prior to the act of receiving input selecting the second program, the act of provisionally programming the recording apparatus to schedule recording of all showings of the repeating first program (Column 10 Lines 48-67 describes the systems function of selecting program to be recording based on if a recording conflict occurs).

[claims 18, 20, & 21]

In regard to Claims 18, 20, and 21, Ward et al discloses the following methods:

- Act of receiving input selecting the repeating first program is conducted after the act of receiving input selecting the second program (Figure 2 shows the input means used to input the selection of recording as described in Column 3 Lines 12-67+ through Column 4 Lines 1-20 which describes the receiving of the user input to select information pertaining to recording of the broadcast); and
- Second program is a non-repeating program (Figure 6 shows various programs that are repeating and non-repeating).

[claim 22]

In regard to Claim 22, Ward et al discloses a system that includes a recording apparatus, a method for resolving conflicts between programs that have been selected for recording and have coinciding broadcast times, the method comprising the acts of:

- Receiving input selecting a second program for recording, the second program having an expected second broadcast time having an expected start time and an expected end time (Figure 2 shows the input means used to input the selection of recording as described in Column 3 Lines 12-67+ through Column 4 Lines 1-20 which describes the receiving of the user input to select information pertaining to recording of the broadcast);
- Monitoring broadcast data on a channel on which the second program is to be broadcast to determine that at least one of an actual start time and an actual end time differs from the respective expected start time and expected end time (Figure 6 shows the monitoring of programs while Column 11 Lines 50-67 describes the determination of the correct start and end times); and
- Upon determining that at least one of an actual start time and an actual end time differs from the respective expected start time and expected end time

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determining whether both the first program and the second program can be recorded, and, if so, recording both the first program and the second program using the recording apparatus (Column 12 Lines 37-67 describes the conflict resolution that is used when it is determined that a conflict could occur and thereby resolving the conflict).

[claims 23 & 24]

In regard to Claims 23 and 24, Ward et al discloses the first broadcast time does not coincide with the expected second broadcast time and the first broadcast time at least partially coincides with an actual second broadcast time defined by the actual start time and the actual end time such that:

- Act of determining whether both the first program and the second program can be recorded results in a determination that one of the first program and the second program can not be recorded (Column 12 Lines 37-67 describes the determination if the programs can be recorded without conflict); and
- Act of recording all of the second program during the actual second broadcast time as opposed to recording only that portion of the second program that is broadcast during the expected second broadcast time (Column 13 Lines 1-17 describes the act of recording the entire second program).

[claim 25]

In regard to Claim 25, Ward et al discloses a method wherein the first broadcast time at least partially coincides with the expected second broadcast time and the first broadcast time does not coincide with an actual second broadcast time defined by the actual start time and the actual end time, such that:

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- Conflict between the first broadcast time and the expected second broadcast time is resolved and both the first program and the second programs are recorded (Column 13 Lines 1-17 describes the resolution of the conflict between the two programs and that both programs are recorded).

[claim 26]

In regard to Claim 26, Ward et al discloses a system that includes a recording apparatus and an electronic program guide, a method for responding to dynamic conditions associated with the system so as to identify programs to be recorded after a conflict between selected programs is resolved, the method comprising:

- User input selecting a first program for recording, programming the recording apparatus to record the first program at a first broadcast time using the electronic program guide (Column 12 Lines 36-67 describes the user selecting the importance of the program and thereby letting the user determine importance of the program);
- Receiving user input selecting a second program for recording, the second program having a second broadcast time that at least partially coincides with the first broadcast time (Figure 2 shows the input means used to input the selection of recording as described in Column 3 Lines 12-67+ through Column 4 Lines 1-20 which describes the receiving of the user input to select information pertaining to recording of the broadcast);
- Determining that a conflict exists between the first program and the second program, such that the second program is not to be recorded unless the conflict is resolved (Column 12 Lines 37-67 describes the system determining that a conflict exists);

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- Storing system information specifying that the user has selected the second program for recording so as to preserve the possibility of resolving the conflict at a later time, then (Column 12 Lines 55-67 describes the storing of information pertaining to recording the second program at a different time);
- In response to subsequent revaluation of the conflict between the first program and the second program based on the stored system information, determining that the conflict has been resolved; (Column 13 Lines 1-17 describes the determination that the conflict has been resolved); and
- Automatically programming the recording apparatus to schedule recording of the second program (Column 13 Lines 1-17 describes programming the recording apparatus)

[claim 27, 29, 30, & 31]

In regard to Claims 27, 29, 30, and 31 Ward et al discloses the method wherein conflicts are resolved upon:

- the system receiving user input deselecting the first program (Column 11 Lines 30-67 describes the system receiving user input to deselect the first program);
- the first program being preempted such that the first program is not broadcast at the first broadcast time (Column 11 Lines 50-67 describes what the system will do if the broadcast is not broadcast at the set broadcast time);
- at least one of a start time and an end time of at least one of the first program and the second program changing from that which was scheduled, such that no portion of the first program coincides with any portion of the second program (Column 11 Lines 50-67 describes the change of start times and end times and the adjustment of recording); and

- system performing the act of determining that an episode of the second program to be shown at the second broadcast time is also to be shown at another broadcast time that does not conflict with the first broadcast time, the act of automatically programming the recording apparatus to record the second program comprising the act of programming the recording apparatus to record the second program at said other broadcast time (Column 13 Lines 1-17 describes the recording of the program at a different broadcast time).

[claims 32 & 33]

In regard to claims 32 and 33, Vallone et al discloses the method further comprises the acts of:

- prior to the conflict being resolved, receiving user input selecting a third program for recording at a third broadcast time (Column 7 Lines 35-57 describes that the user can select various program to be recorded); and
- prior to the act of programming the recording apparatus to record the second program and after the conflict is resolved, reconsidering which of the selected programs, including the second program and the third program, are to be recorded, using a priority list that lists the programs in an original order in which the selected programs were selected or using a priority list that lists the selected programs first by whether the recording apparatus was originally programmed to record the selected programs and second in an original order in which the selected programs were selected (Column 13 Lines 1-20 describe the act of programming the recording apparatus for an additional program)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward et al (US 6,756,997) in view of Vallone et al (6,642,939).

[claims 6 & 28]

In regard to Claims 6 and 28, Ward et al discloses a system that resolves conflict of two programs both to be recorded at the same time; however fails to disclose that a resolution to be to an additional tuner being made available at the system, such that both the first program and the second program can be recorded simultaneously. Vallone et al discloses a system wherein various tuners are available to send various inputs into the system to allow recording of multiple shows as seen in Figure 2 element 201-204. The additional tuner allows for the system the viewer to watch, record and select multiple programs. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conflict resolution system, as disclosed by Ward et al, and incorporate a system that has additional tuners that permit additional storage of broadcast segments, as disclosed by Vallone et al.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- Hennig (US 5,956,455);
- Marsh et al (US 6,208,799);
- Lemmons (US 5,880,768).


Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Vent whose telephone number is 571-272-7384. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamie Vent
05/26/05


THAI TRAN
PRIMARY EXAMINER